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| 09/932,741 | 08/17/2001 | Lee E. Cannon | 4657US(300-015) | 4593 |

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| EXAMINER |
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BROCKETTI, JULIE K

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| ART UNIT | PAPER NUMBER |
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3713

DATE MAILED: 07/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|--------------------------------|--------------------------------|--|
| Office Action Summary | Application No. 09/932,741 | Applicant(s) CANNON, LEE E. | |
| | Examiner Julie K. Brockett. | Art Unit 3713 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 38,39,41-50 and 64-105 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 38,39,41-50 and 64-105 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 November 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>01132004</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on January 13, 2004 has been entered.

Drawings

The drawings are objected to under 37 CFR 1.83(a), 1.84(n) and 1.84(o).

1.83(a) states:

The drawing in a nonprovisional application must show every feature of the invention specified in the claims. However, conventional features disclosed in the description and claims, where their detailed illustration is not essential for a proper understanding of the invention, should be illustrated in the drawing in the form of a graphical drawing symbol or a labeled representation (e.g., a **labeled rectangular box**).

1.84(n) states:

Symbols. Graphical drawing symbols may be used for conventional elements when appropriate. The elements for which such symbols and labeled representations are used must be adequately identified in the specification. Known devices should be illustrated by symbols, which have a universally recognized conventional meaning and are generally accepted in the art. Other symbols, which are not universally recognized may be used, subject to approval by the Office, if they are not likely to be confused with existing conventional symbols and if they are readily identifiable.

1.84(o) states:

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Legends. Suitable descriptive legends may be used subject to approval by the Office, or may be required by the examiner where necessary for understanding of the drawing. They should contain as few words as possible.

The drawings cannot consist solely of boxes and reference numbers. By looking at the drawings alone it is unclear as to what the invention encompasses. Furthermore, it is burdensome to look at the specification and match up the empty boxes with what they represent. To fully understand the drawings legends for the different items are required. The boxes must be labeled as to what they are and/or redrawn to represent the real shape of the object they are intended to represent.

Claim Objections

Claims 95 and 96 are objected to because of the following informalities: There are two claim 96s in the application and no claim 95. Please change the first claim 96 to claim 95. For this office action, the first claim 96 will be called claim 95. Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 38, 39, 41-46, 64, 65, 67-69, 71-76, 79-83, 90-94, 96-98 and 101-105 are rejected under 35 U.S.C. 102(b) as being anticipated by Marnell, II, U.S. Patent No. 5,393,057. Marnell discloses a method for playing a group game. Each of a plurality of plays of individual games are played by a plurality of players at respective gaming machine in which an outcome is generated for the individual game. The outcome is one of a plurality of outcomes including at least one specific outcome (See Marnell col. 2 lines 35-67; col. Figs. 1 & 2). At least one group of cells is displayed. Each cell in the at least one group of cells is capable of being designated with a designator in response to any player of the plurality of players achieving the at least one specific outcome. The designator indicate the gaming machine at which the at least one specific outcome was generated. A cell of the at least one group of cells is designated with the designator responsive to each occurrence of the at least one specific outcome (See Marnell Figs. 1 & 2; col. 6 lines 1-8, 60-67) [claims 38, 105]. For example, the player plays a poker or slot machine game and based on the outcome of that game if any of the outcome is included in the bingo matrix, the player gets their gaming machine number placed in the cell of the bingo matrix. At least one payout to the plurality of players is determined in relation to respective numbers of designated cells of a first group of cells of the at least one group of cells that correspond to each gaming machine (See Marnell col. 7 lines 7-14; col. 10 lines 7-23) [claim 39].

At least one payout comprises apportioning the at least one payout according to respective numbers of designations in the designated cells of the first group of cells that correspond to each gaming machine (See Marnell col. 7 lines 7-14) [claim 41]. At least one payout among the plurality of players is distributed according to respective numbers of designations in the designated cells of the first group of cells that correspond to each gaming machine (See Marnell col. 7 lines 7-14; col. 10 lines 7-24) [claim 42]. At least one group of cells comprises two or more rows of cells (See Marnell Fig. 1) [claim 43]. An award value associated with each row of the two or more rows of cells is provided (See Marnell col. 7 lines 7-14) [claim 44]. At least one group of cells are configured as a group of playing card indicia and the game provides a player card indicia of the group of playing card indicia for each cell of the at least one group of cells (See Marnell Fig. 1) [claim 45]. The individual game comprises draw poker (See Marnell col. 4 lines 5-9) [claim 46]. Wagers are received from a plurality of players at respective gaming machines (See Marnell col. 4 line 18). Outcomes of individual games played by the plurality of players are determined at the respective gaming machines (See Marnell col. 2 lines 35-67; col. Figs. 1 & 2). An image representing a group game played by all of the players is displayed at the respective gaming machines is displayed. The image is representative of the group game and comprises a first plurality of cells corresponding to the group goal. The group game includes taking a first plurality of steps toward a first group goal. Each step/cell of the first plurality of steps/cells is

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attributable to any of the respective gaming machines of the plurality of players. For each outcome from a first set of outcomes, an image representative of taking one step of the first plurality of steps towards the first group goal is displayed wherein the image representative of taking the one step of the first plurality of steps towards, the group goal includes a designation indicative of the respective gaming machine at which the outcome from the first set of outcomes was determined. A value payout associated with the group game is provided based on the outcomes of the individual games played by the plurality of players at the respective gaming machines (See Marnell Figs. 1, 2, 5, col. 2 lines 35-67; col. 9 lines 49-60; col. 10 lines 7-24) [claims 64, 81, 105]. The image representative of the group game comprises a plurality of cells, wherein each cell of the plurality of cells corresponds to each step of the first plurality of steps. Displaying the image representative of taking one step of the first plurality of steps towards the first group goal comprises designating the cell of the plurality of cells corresponding to the step of the first plurality of steps with the designation indicative of the respective gaming machine at which the outcome from the first set of outcomes was determined (See Marnell Fig. 1; col. 7 lines 1-14) [claims 65, 105]. Each outcome of the first set of outcomes corresponds to a respective cell of the plurality of cells (See Marnell Fig. 1) [claim 67]. Designating the cell of the plurality of cells can comprise removing a previous designation, if any (See Marnell col. 10 lines 24-49) [claims 68, 92]. Designating the cell of the plurality of cells comprises not

designating the cell if the cell was previously designated (See Marnell col. 9 lines 15-19) [claims 69, 93]. The first group goal includes achieving a predetermined number of outcomes from the first set of outcomes (See Marnell col. 6 lines 18-23) [claims 71, 82]. The first group goal includes achieving each outcome from the first set of outcomes at least once (See Marnell col. 6 lines 18-23) [claim 72]. The group game includes taking a second plurality of steps toward a second group goal, wherein each step of the second plurality of steps is attributable to any of the respective gaming machines of the plurality of players. For each outcome from a second set of outcomes, an image representative of taking one step of the second plurality of steps towards the second group goal is displayed, wherein the image representative of taking the one step of the second plurality of steps towards the second group goal includes a designation indicative of the respective gaming machine at which the outcome from the second set of outcomes was determined (See Marnell col. 6 lines 23-27) [claims 73, 102]. For example, a first goal is a first bingo game matrix, once a bingo occurs in that matrix, the board is cleared and a second group goal, i.e. a second bingo matrix is generated, for the players to attempt to achieve bingo on. The first group goal has associated with it a first value payout, and the second group goal has associated therewith a second value payout (See Marnell col. 7 lines 7-14; col. 10 lines 7-23) [claims 74, 103]. In response to outcomes from the first set of outcomes, steps of the first plurality of steps are attributed to the players at whose gaming machines the outcomes

were determined, wherein providing the value payout comprises apportioning the value payout among a set of players of the plurality of players to whom steps of the first plurality of steps are attributed (See Marnell col. 7 lines 1-14) [claim 75]. Apportioning the value payout among the set of players is based on the number of steps of the first plurality of steps attributed to each player of the set of players (See Marnell col. 7 lines 1-14) [claim 76]. The individual games comprise at least one of a reel-type slot machine game, a poker game, a blackjack game, a keno game, a lotto game and a bingo game (See Marnell col. 3 lines 54-62) [claims 79, 104]. An image representing an individual game played by one of the plurality of players is displayed (See Marnell Fig. 1) [claims 80, 101]. A number of designated cells of the first plurality of cells correspond to a number of outcomes from the first set of outcomes achieved by the plurality of players (See Marnell Fig. 1) [claim 83]. Each cell of the first plurality of cells corresponds to at least one outcome from the first set of outcomes (See Marnell Fig. 1) [claim 90]. Achieving the first group goal corresponds to designating all of the cells in the first plurality of cells (See Marnell col. 6 lines 18-20) [claim 91]. The image representative of the group game includes a plurality of playing cards. Each playing card of the plurality of playing cards comprises a respective cell of the first plurality of cells. Designating the cell from the first plurality of cells comprises designating a playing card from the plurality of playing cards (See Marnell Fig. 1; col. 6 lines 1-13) [claim 94]. Providing the value payout comprises providing the value

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payout when all of the cells of the first plurality of cells have been designated (See Marnell col. 6 lines 18-24) [claim 96]. Providing the value payout comprises apportioning the value payout among players whose gaming machine corresponds to at least one of the designated cells (See Marnell col. 7 lines 1-14) [claim 97]. The value payout is apportioned based on the number of cells corresponding to each gaming machine (See Marnell col. 7 lines 1-14) [claim 98]. The gaming system comprises a plurality of gaming machines wherein each gaming machine comprises a gaming machine controller comprising a processor and a memory operatively coupled to the processor. The gaming machine controller is configured to perform the steps mentioned above (See Marnell Figs. 4, 5) [claim 105].

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 70, 77, 78, 95, 99 and 100 are rejected under 35 U.S.C.

103(a) as being unpatentable over Marnell, U.S. Patent No. 5,393,057.

Marnell lacks in disclosing allowing the cell to have multiple designations. It would have been obvious to one of ordinary skill in the art at the time the

invention was made to allow designation of the cell of the plurality of cells if the cell was previously designated, wherein the designated cell of the plurality of cells has associated therewith multiple designations [claims 70, 99]. By allowing multiple designations of the cell more players are capable of winning a share of the payout. Therefore, players can be rewarded for obtaining certain outcomes even if other players obtained them first. Consequently, the game becomes more enjoyable to players by giving them more chances to win. While Marnell does disclose that each step of the first plurality of steps corresponds to a portion of the value payout, Marnell lacks in disclosing that each step of the first plurality of steps is capable of being attributed to multiple players wherein apportioning the value payout among a set of players comprises apportioning each portion of the value payout to the one or more players attributed to the step corresponding to the portion of the value payout. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have each step of the first plurality of steps is capable of being attributed to multiple players wherein apportioning the value payout among a set of players comprises apportioning each portion of the value payout to the one or more players attributed to the step corresponding to the portion of the value payout [claims 77, 99]. By allowing multiple designations of the cell more players are capable of winning a share of the payout. Therefore, players can be rewarded for obtaining certain outcomes even if other players obtained them first. Consequently, the game becomes more enjoyable to players by

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giving them more chances to win. Marnell also lacks in disclosing that each of the first steps is capable of being attributed to a single player multiple times. It would have been obvious to one of ordinary skill in the art at the time the invention was made to allow a single player to achieve multiple outcomes of the same game outcome [claims 78, 100]. If a player achieves multiple outcomes they should be rewarded for this by apportioning each portion of the value payout based on the number of times a player is attributed to the step corresponding to the portion of the value payout. By rewarding a player for all of their individual outcomes, the player will enjoy the game more.

Furthermore, if one is rewarding multiple players for obtaining the same outcome, one should also reward a single player for obtaining the outcome more than once in order to be fair. At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to designate the indicia by crowning the playing card indicia because Applicant has not disclosed that the crowning provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Marnell's game, and applicant's invention, to perform equally well with either lighting up the designated playing card indicia as taught by Marnell or crowning the indicia because both ways would perform the same function of designating the playing card indicia so that a player would recognize that they have achieved that outcome. Therefore, it would have been prima facie obvious to modify Marnell

to obtain the invention as specified in claim 95 because such a modification would have been considered a mere design consideration which fails to patentably distinguish over the prior art of Marnell.

Claims 47-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marnell in view of Tallarida, U.S. Patent No. 3,618,952.

Marnell discloses all of the limitations above and also discloses that the designated cell comprises designating playing card indicia (See Marnell Fig. 1) [claim 49]. Marnell discloses designating the playing card indicia by lighting it up in the matrix. At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to designate the indicia by crowning the playing card indicia because Applicant has not disclosed that the crowning provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Marnell's game, and applicant's invention, to perform equally well with either lighting up the designated playing card indicia as taught by Marnell or crowning the indicia because both ways would perform the same function of designating the playing card indicia so that a player would recognize that they have achieved that outcome. Therefore, it would have been prima facie obvious to modify Marnell to obtain the invention as specified in claim 50 because such a modification would have been considered a mere design consideration which fails to patentably distinguish over the prior art of Marnell. Marnell lacks in disclosing that each row of playing card indicia

comprises a different suit. Tallarida teaches of a game in which there are at least one group of cells, comprising four rows of cells, each row of cells comprising a row of playing card indicia, each row of playing card indicia comprising a different suit (See Tallarida Fig. 2, col. 1 lines 60-75) [claim 47]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have each row of playing card indicia comprise a different suit. Marnell clearly teaches of putting different playing card indicia into the bingo matrix. Tallarida teaches of organizing bingo indicia by playing card suit. Therefore, it is obvious to organize the playing card indicia of Marnell by playing card suit so that players could compete to obtain certain indicia by suit. Furthermore, Marnell teaches of a royal flush being one of the cells in the matrix (See Marnell col. 8 line 54). Therefore, it is also obvious that each different suit of the row of playing card indicia could comprise a hand including a royal flush.

Claims 66, 84-89 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marnell in view of the Price is Right game "Pathfinder".

Marnell lacks in disclosing that the designation of the cells is in order. The game "Pathfinder" teaches of a plurality of cells in which the cells are lit up in order, i.e. in order of the price of the car. Therefore, the plurality of cells are arranged in order; wherein designating the cell of the plurality of cells comprises designating a next cell in the order form the plurality of cells (See "Pathfinder") [claims 66, 84]. One can consider the game of "Pathfinder" to be

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in the form of a ladder comprising a first plurality of cells wherein the ladder has a top and a bottom. Designating the cell from the first plurality of cells comprises designating the next undersigned cell from the bottom of the ladder [claim 85]. If the next undesigned cell is designated, an image of a figure on the ladder moving toward the top by one cell is displayed (See Pathfinder) [claim 86]. For example, the image is the person actually walking along the path. One can also consider the game of "Pathfinder" to be in the form of a lane comprising a first plurality of cells wherein the lane has a beginning and an end. Designating the cell from the first plurality of cells comprises designating the next undersigned cell from the beginning of the lane [claim 87]. If the next undesigned cell is designated, an image of an object on the lane moving toward the end by one cell is displayed (See Pathfinder) [claim 88]. Pathfinder teaches that the object in the lane is a person. Absent of showing a criticality, the object in the lane could be a car, which is a design choice [claim 89]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have the plurality of cells of Marnell be in order and have the players achieve the outcomes "in order". For example, by requiring the player to achieve an outcome in the "B" column first and then the "I" column, etc. makes the game more challenging and entertaining to the players. The more difficult it is to achieve a "bingo" the less that the player's will win and the more money the casino will make.

Response to Arguments


Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Julie K. Brockett whose telephone number is 571-272-4432. The examiner can normally be reached on M-Th 8:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xuan Thai can be reached on 571-272-7147. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Julie K Brockett
Primary Examiner
Art Unit 3713